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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,526	08/19/2003	Brian M. Wilk	27087/39520	4491

4743 7590 09/28/2004

MARSHALL, GERSTEIN & BORUN LLP  
6300 SEARS TOWER  
233 S. WACKER DRIVE  
CHICAGO, IL 60606

EXAMINER

MENDIRATTA, VISHU K

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/643,526

Applicant(s)

WILK ET AL.

Examiner

Vishu K Mendiratta

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 45-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 45-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/21/03.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-126,45-51, drawn to game piece, classified in class 273, subclass 288.
  - II. Claims 36-44, drawn to method of playing a game, classified in class 273, subclass 242.
  - III. Claims 27-35, drawn to alternate method of playing a game, classified in class 273, subclass 255.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions apparatus, method and alternate method with engagement.
3. During a telephone conversation with Thomas Stine on 9/22/04 a provisional election was made without traverse to prosecute the invention of Apparatus, claims 1-26 and 45-51. Affirmation of this election must be made by applicant in replying to this Office action. Claims 27-44 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Note: In his telephone message the attorney requested to send a new preliminary amendment. The examiner is not authorized to include any new preliminary amendment while in the middle of examination.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3,5-6,9-13,15-22,25-26,45-51 rejected under 35 U.S.C. 102(b) as being anticipated by Potter (2052035).

Potter teaches a game character (Fig.8-11) having a base (244,245), devise for measuring distance (232), visible indication of distance (242), audible indication of distance (6:25-30), kicking device/weapon (253), projectile launcher (258,259,260), axle (236) and wheel/roller (238,248) attaching the surface, a plurality of gear teeth (249) and clicker (250) within a chamber (246), as can be seen that indicia (242) are alternately seen and shielded in the playing piece through the open aperture at the top, the axle fixedly secured to wheel(237) and pinion (235) and a rack(239) with indicia.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4,14 rejected under 35 U.S.C. 103(a) as being unpatentable over Potter.

Potter teaches playing piece with visual indicator and audible indicator in separate embodiments but not within the same embodiment.

Whereas a person with normal vision can read the indicia, it would not be possible for a visually challenged person to play the game. In order to help both categories, it would have been obvious to include both visual indicia and audible indicator. One of ordinary skill in art at the time the invention was made would have suggested both visible indicia and audible indicator within same embodiment.

Potter teaches all limitations except teeth on gear.

In the art area of amusement such recording devices with gear teeth arrangement are commonly known and used. In order to create a variation it would have been obvious to use such techniques. One of ordinary skill in art at the time the invention was made would have used gear teeth arrangement in a game piece. It may be noted that

5. Claims 7,8,23,24 rejected under 35 U.S.C. 103(a) as being unpatentable over Potter in view of Andrews (2003/0220044 A1).

Potter teaches all limitations except that it does not teach a spring loaded weapon launcher.

Andrews teaches a spring loaded (summary) weapon launcher. Games and amusement articles with such arrangements are commonly available in toy stores. Such launchers simulate real weapons and attract people. In order to attract people it would have been obvious to simulate playing pieces to real launchers. One of ordinary skill in art at the


time the invention was made would have suggested providing spring launcher for simulation of real weapons and attract people.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. 4317570,6659463,2004/00119234A1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishu K Mendiratta whose telephone number is (703) 306-5695. The examiner can normally be reached on Mon-Fri 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Vishu K Mendiratta  
Primary Examiner  
Art Unit 3712

VKM  
September 23, 2004